

SERIAL NO. 09/552,073  
ATTORNEY DOCKET NO.: 4526-29945

summary of the claims is provided for the examiner's convenience. For the record, this summary is presented not by way of limitation, or interpretation, or formal characterization, or to be subject to an estoppel, but rather merely for the convenience of the examiner in ascertaining certain differences between the subject matter of the claims to thereby facilitate examination.

The claims in this case are generally directed to a system and method in which an individual who does not have a bank account with a particular financial institution is able to have funds directly deposited into a temporary account with a financial institution such as a bank, have funds directly swept from the account at the financial institution by a non-banking entity such as a licensed money transmitter, and obtain the funds in the form of a negotiable instrument from the licensed money transmitter (Application page 2, lines 10-24). The system also enables the individual to conduct anonymous transactions using a prepaid negotiable instrument (Application page 3, lines 8-9).

In particular, claim 26 is directed, among other things, to aspects of an improvement to a licensed money transmitter payment system for issuing a negotiable instrument (such as a "CASH CARD" or money order or other type of instrument) in response to a direct deposit of funds at an affiliated regulated financial institution.

Claim 48 is directed, among other things, to aspects of a method for a licensed money transmitter to issue a prepaid negotiable instrument (not necessarily a card) based on direct deposit of funds at a regulated financial institution.

Claim 58 is directed, among other things, to aspects of a computer-controlled negotiable instrument payment system based on direct deposit of funds at a regulated financial institution, utilizing a licensed money transmitter's computer system.

Claim 85 is directed, among other things, to aspects of a method for a licensed money transmitter to provide direct deposit capability to individuals not having a pre-established relationship with a regulated financial institution, and to conduct financial transactions with a cash card for accessing funds corresponding to the direct deposit.

Claim 118 is directed, among other things, to aspects of a method for a licensed money transmitter to issue a prepaid negotiable instrument to an individual based on the

SERIAL NO. 09/552,073  
ATTORNEY DOCKET NO.: 4526-29945

direct deposit of funds at a regulated financial institution, based on use of an account number and a PIN.

Claim 122 is directed, among other things, to a computer-controlled negotiable instrument payment system for use by a licensed money transmitter, for conducting negotiable instrument transactions conducted by an individual based on the direct deposit of funds at a regulated financial institution.

Note that all of the claims in either of Groups I or II involve direct deposit of funds and prepaid negotiable instruments. The examiner has apparently missed the commonality of the claims that should result in a conclusion that the claims of Groups I and II should remain together in the same application and patent. The relationship between the claim sets was more fully explained in the office action response paper filed on Feb. 20, 2004 – as well as reasons provided for patentability.

There are eight independent claims in this case. Of these eight claims, the six in Groups I and II are related to the general notion of issuing a negotiable instrument in response to the direct deposit of funds at a regulated financial institution. This is a common thread to all of these claims. Each of these claims includes aspects involving a licensed money transmitter, a regulated financial institution, a transaction account, direct deposit of funds, sweeping funds into the transaction account in response to the direct deposit, and issuance of a negotiable instrument.

It would be anomalous to separate claim 58 (in Group I) from claim 122 (in Group II), as both are directed to systems with an account sweep computer program module and a transaction control module.

The examiner indicated the claims in Group I would be classified in class 705, subclass 39, while the claims in Group II would be in class 705, subclass 51. Class 705/39 is described in the Classification Manual as “Automated Electrical Financial or Business Practice or Management Arrangement, Finance (e.g., banking, investment or credit), including funds transfer or credit transaction.” The applicant does not object to this class as potentially appropriate for searching for relevant prior art.

However, class 705/51 is “Business Processing Using Cryptography, usage protection of distributed data files.” Where on earth did the examiner come up with that?

SERIAL NO. 09/552,073  
ATTORNEY DOCKET NO.: 4526-29945

This does not make any sense. There is no recitation anywhere in any claims of Group II relating to cryptography in any form or fashion. Although cryptography could certainly be used in a system constructed in accordance with the invention, there are no cryptography elements in the claims.

The examiner's selection of class 705/51 for Group II is incorrect and it is respectfully requested that the examiner reconsider not only the selection of this class as a justification for separation, but also that the claims in this group properly belong with, and should be examined with, the claims of Group I.

The reasoning provided by the examiner that these different groups are "separately usable" and that they have acquired "separate status in the art" simply does not make any sense and appears to be a rote recitation of the requirements in the MPEP and CFR for making a restriction requirement. The comments provided by the examiner selectively omit aspects important in considering the claims – for example, why did the examiner fail to mention on page 3, paragraph 6, that the claims of Group I involve a negotiable instrument? It is mentioned for Group II in the very next sentence. As mentioned, claims in Groups I and II involve negotiable instruments, direct deposit, account sweeping, a transaction account, etc.

Furthermore, it is noted for the record that classification has already been made and searches have already been conducted by the previous examiner in this case, Dr. Akers. Interviews have already been conducted. An RCE has already been filed. For the Office to switch to a new examiner, and impose a restriction requirement at this stage, on the tenuous grounds that the subject matter has "acquired a separate status in the art" is disingenuous and incorrect. The distinctions drawn by the examiner as to "separate utility" are not well reasoned.

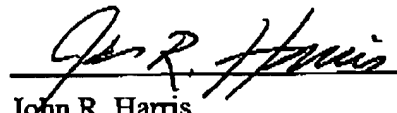
Similar observations can be made for the strained conclusion that these so-called subcombinations "have separate utility." If the "separate utility" argument is taken to its logical conclusion, then no patent could ever issue with more than one independent claim – arguably every independent claim has "separate utility" using the flawed reasoning applied by the examiner. This is not a case where there is a clear justification for separating these claims into this artificial grouping.

SERIAL NO. 09/552,073  
ATTORNEY DOCKET NO.: 4526-29945

The Office has already delayed enough in bringing this case to a resolution. The art cited and applied in previous Office Actions is simply inapposite, and now -- we have further delay with contrived reasons to separate the subject matter into three different groups (not two, which would have been more logical) along lines that do not make any sense.

The examiner is strongly urged to withdraw the restriction requirement, at least with respect to Groups I and II, and allow a patent to issue without further delay.

Respectfully submitted,



John R. Harris  
Reg. No. 30,388  
Attorney for Applicant  
MORRIS, MANNING & MARTIN, LLP  
1600 Atlanta Financial Center  
3343 Peachtree Road, N.E.  
Atlanta, Georgia 30326

Dated: August 12, 2004  
Tel. No.: 404-233-7000  
Fax. No.: 404-365-9532  
Atty. Docket No.: 4526-29945